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EXAMINER
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SALCE, JASON P

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ROB MYERS, RICHTER A. RAHEY, KLAUS HOFRICHTER,  
and HAROLD AARON LUDTKE

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Appeal 2011-005174  
Application 09/524,770  
Technology Center 2400

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Before JEFFREY S. SMITH, MICHAEL R. ZECHER, and JULIE K.  
BROCKETTI, Administrative Patent Judges.

SMITH, Administrative Patent Judge.

DECISION ON APPEAL

## STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 16, 18-29, 41, and 42, which are all the claims remaining in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

### Invention

Appellants' invention relates to a service module for a dedicated on-site media service. The service module enables a dedicated media service for a broadcast signal. The electronic media module includes a tuner, a media storage device, and an adapter. The tuner, which is coupled to the media storage device, or portion thereof, is constantly tuned to receive a single broadcast signal, thereby ensuring a dedicated path for the broadcast signal. The media storage device provides a guaranteed capacity for storing the broadcast signal. The adapter in turn, is coupled to the media storage device and to the tuner. The adapter is provided for interfacing the tuner and the media storage device of the electronic media module with an electronic media system. A content provider has remote control over the content that is recorded onto the on-site dedicated media storage device. The content provider also has remote control over the on-site presentation of the stored media to the viewer. Multiple dedicated service modules installed on-site allow these functions to be applied across multiple content-providers simultaneously. Abstract.

### Representative Claim

16. A method of enabling an on-site media service, said method comprising:

formatting a media signal with content data and with on-site media service data, wherein the on-site media service data includes a command from an off-site broadcaster that instructs an on-site media system to record the content data without intervention of a user;

broadcasting said media signal to an on-site media system having a dedicated tuning device and a dedicated portion of a hard disk for said media signal, wherein said on-site media service data allows the off-site broadcaster to remotely control a display of an advertisement on said on-site media system and the advertisement is enabled in a transition between two programs during a channel changing event and said on-site media service data further includes metadata that allows the user to locate a specific segment of the content data.

### *Examiner's Rejections*

Claims 16, 18-20, 23, 25, 26, 28, 29, 41, and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hendricks (US 5,798,785), Goldschmidt Iki (US 6,226,444 B1), Barton (US 6,233,389 B1), and Grossman (US 5,907,321).

Claims 21, 22, 24, and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hendricks, Goldschmidt Iki, Barton, Grossman, and Alexander (US 6,177,931 B1).

### Claim Groupings

In view of Appellants' arguments in the Appeal Brief, we will decide the appeal on the basis of claims 16 and 21. See 37 C.F.R. § 41.37(c)(1)(vii).

## ISSUE

Did the Examiner err in finding that the combination of Hendricks, Goldschmidt Iki, Barton, Grossman teaches “metadata that allows the user to locate a specific segment of the content data” as recited in claim 16?

## FINDINGS OF FACT

We adopt the findings of fact made by the Examiner in the Final Rejection and the Examiner’s Answer as our own.

## PRINCIPLES OF LAW

### Claim Interpretation

During examination, claims are to be given their broadest reasonable interpretation consistent with the specification, and the language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (citations omitted). The Office must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. *Id.* (citations omitted).

Our reviewing court has held that non-functional descriptive material cannot lend patentability to an invention that would have otherwise been anticipated by the prior art. See *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). Cf. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). The content of non-functional descriptive material is not entitled to weight in the patentability analysis. See *In re Lowry*, 32 F.3d

1579, 1583 (Fed. Cir. 1994) (“Lowry does not claim merely the information content of a memory.”). See also *Ex parte Nehls*, 88 USPQ2d 1883, 1887-90 (BPAI 2008) (precedential) (discussing non-functional descriptive material).

### ANALYSIS

Rejection of claims 16, 18-20, 23, 25, 26, 28, 29, 41, and 42

Appellants contend that Goldschmidt Iki does not teach “metadata that allows the user to locate a specific segment of the content data” as recited in claim 16. In particular, Appellants contend that the system of Goldschmidt Iki does not record commercials, therefore, the user cannot locate commercials in the recorded program. Appellants further contend that the system controller of Goldschmidt Iki locates the commercials, not the user. App. Br. 4-5; Reply Br. 2.

The Examiner finds that the commercial indicators taught by Goldschmidt Iki allow the system to locate commercials in a program. The Examiner further finds that the system of Goldschmidt Iki allows a user to select a program to record, and to record the program with or without commercials. The Examiner concludes that the commercial indicators allow the user, after selecting a program to record without recording commercials, to locate specific segments of the content data within the meaning of claim 16. Ans. 11-13.

Appellants’ contention that the user cannot locate commercials in the recorded program because the commercials are no longer part of the recorded program is not commensurate with the scope of the claim. Claim 16 does not recite that the metadata allows a user to locate a specific

segment of “recorded” content data. Rather, claim 16 recites that the metadata “allows the user to locate a specific segment of the content data,” regardless of whether the content data is recorded.

Further, Appellants’ contention that the system controller of Goldschmidt Iki, not the user, locates the commercials is unpersuasive. A user selects a program to record without commercials using the interface 620 shown in Fig. 6 of Goldschmidt Iki. The commercials are then located using the commercial indicators. Col. 6, ll. 18-30; col. 8, ll. 45-60. We find that the term “metadata that allows a user to locate a specific segment of the content data” encompasses commercial indicators that allow a user, through the interface 620, to locate commercials that are broadcast in a program as taught by Goldschmidt Iki. Therefore, we agree with the Examiner that Goldschmidt Iki teaches “metadata that allows the user to locate a specific segment of the content data” as recited in claim 16.

Further, the “metadata that allows the user to locate a specific segment of the content data” is non-functional descriptive material that is not entitled to patentable weight. The “metadata” is not functionally involved in the steps recited, nor does the “metadata” alter any recited structural elements. The recited method steps would be performed the same regardless of the specific content of the “metadata.” The claim only recites that the on-site media service data includes “metadata” that is not used in any of the recited steps. Thus, the claimed “metadata” is non-functional descriptive material which does not distinguish the claimed invention from the prior art in terms of patentability.

We sustain the rejection of claim 16 under 35 U.S.C. § 103(a).  
Appellants have not presented arguments for separate patentability of claims 18-20, 23, 25, 26, 28, 29, 41, and 42, which thus fall with claim 16.

Rejection of claims 21, 22, 24, and 27

Appellants contend that Alexander does not teach metadata that allows a user to locate a specific segment of content data as recited in claim 16. App. Br. 5-6. However, Goldschmidt Iki teaches the metadata as discussed in the analysis of claim 16.

We sustain the rejection of claims 21, 22, 24, and 27 under 35 U.S.C. § 103(a).

### CONCLUSION OF LAW

The Examiner did not err in finding that the combination of Hendricks, Goldschmidt Iki, Barton, Grossman teaches “metadata that allows the user to locate a specific segment of the content data” as recited in claim 16.

### DECISION

The rejection of claims 16, 18-20, 23, 25, 26, 28, 29, 41, and 42 under 35 U.S.C. § 103(a) as being unpatentable over Hendricks, Goldschmidt Iki, Barton, and Grossman is affirmed.

The rejection of claims 21, 22, 24, and 27 under 35 U.S.C. § 103(a) as being unpatentable over Hendricks, Goldschmidt Iki, Barton, Grossman, and Alexander is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

ELD